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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/905,387

07/13/2001

Elvin Lukenbach

JBP-555

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04/12/2005

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/905,387	<b>Applicant(s)</b> LUKENBACH ET AL.	
	<b>Examiner</b> Gina C. Yu	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/3/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

In view of the appeal brief filed on October 24, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1-7, 9-14, 17-19, 21, 22, 25-29, and 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Dixon (US 6407044 B2).**

Dixon discloses aerosol personal cleansing shower gel composition comprising a mixture of surfactants including anionic, amphoteric, and nonionic surfactants, and low vapor pressure propellants selected from butane, isobutene, and pentane. See col. 15, lines 1 – 48. The reference teaches, “when low vapor pressure hydrocarbon propellants are solubilized in the moisturizing agent in an aqueous surfactant matrix, it has been found that a distinct highly concentrated lamellar phase crystalline structure is formed which results in a further increase in deposition of the moisturizing agent.” See col. 2, lines 37 – 49. Example G contains 5.13 % of anionic surfactant (ammonium lauryl sulfate) and 2 % of cocamidopropyl betaine. See instant claims 5, 6, 9, and 12. Example formulation also contains polymer JR 30M (polyquarternium-10, a cellulose derivative conditioner), and glycerine. See instant claims 26-29. The ratio and amount of the isopentane and isobutene used in the gel composition are also taught. See instant claims 18, 19, 21, and 22. The examples do not contain ethoxylated fatty alcohol, fatty esters, or thickening agents. See instant claims 17 and 25. The reference also teaches that the concentration of the lathering surfactant mixture is 0.5-30 %, preferably from about 2-20 %, and most preferably from about 5-10 %. See instant claim 4. The reference teaches using 8-20 % of anionic surfactants, 1-15 % of

amphoteric surfactants, and 1-15 % of nonionic surfactants that are disclosed in col. 7, lines 15 – 51. See instant claims 5-7, 9-11, 13-15.

While the reference teaches that its composition is in the form of lotion, examiner views that the prior art meets the “gel consistency” limitation of the present claims because the viscosity of the prior art is said to be within the range that applicants requires in this case. See col. 11, lines 30 – 44, which indicates that the most preferred viscosity range of the prior art is in 1,000-40,000 cps. See instant claim 3. Polymers such as cationic guar gum, cationic cellulose, and resins cationic homopolymers of dimethyldialkylammonium chloride are also taught in col. 9, line 40 – col. 10, line 3. See instant claim 26 and 27. The reference teaches to package the composition in appropriate aerosol container, including bag-in-a can. See col. 16, lines 9 – 15; instant claims 31-33.

The viscosity of the surfactant mixture prior to the mixing step in claim 2 is viewed as a process limitation. It is well settled in patent law that, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). In the present case, while the reference fails to teach the viscosity of the surfactant mixture during the process of making the composition, this limitation of claim 2 is not given patentable

weight since the final cleansing composition of the prior art is viewed same as the composition as claimed in the base claim, claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 8, 15, 16, 20, 23, 24, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dixon as applied to claims 1-7, 9-14, 17-19, and 21, 22, 25-29, 31-33 as above anticipatory rejection, and further in view of NoVeon (Carbopol ETD 2020 Technical Data).**

As for claim 20, the ratio of isopentane and isobutene in Example formulas in the Dixon reference is 85:15. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235. See also In re Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382, (Fed. Cir., 2003) ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."). In this case, since the prior art generally teaches the 85:15 ratio of the two foaming agent

used in aerosol shower gel formula to make a highly concentrated liquid crystal phase of the composition, it would have been obvious to one of ordinary skill in the art to have found workable by routine experimentation to make improvement upon the prior art.

While Dixon generally teaches alkyl ether sulfates having C8-C22 and sodium counterions for anionic surfactant and alkyl polyglucosides for nonionic surfactant, the reference fails to specifically mention sodium lauryl ether sulfate and decyl glucoside. See col. 7, lines 15 – 51. Since the recited anionic and nonionic surfactants as recited in the present claims are species of the genus which are disclosed by the prior art, the claimed surfactants would have been obvious to one of ordinary skill in the art.

Furthermore, NoVeon teaches “typical shampoo and bath gel formulas” comprising 4-16 % of sodium laureth sulfate, up to 10 % of decyl glucoside, and up to 10 % of cocamidopropyl betaine. See Experimental Variables table. The reference teaches that the pH of the composition is adjusted to 6.0-6.5. See experimental Responses and Constraints.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Dixon by adding sodium lauryl ether sulfate and decyl glucoside as motivated by NoVeon because the latter teaches that these surfactants are used to make typical personal cleansing formulas. The skilled artisan would have had a expectation of successfully producing a personal cleansing composition because Dixon generally teaches using the genus of the NoVeon surfactants and the same amphoteric surfactant, cocamidopropyl betaine.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

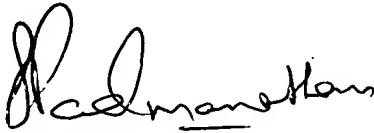
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**